

ESTTA Tracking number: **ESTTA582593**

Filing date: **01/17/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|------------------------|---|
| Proceeding | 91206167 |
| Party | Plaintiff BHPC Associates LLC |
| Correspondence Address | JEFFREY P WEINGART MEISTER SEELIG & FEIN LLP 140 EAST 45TH STREET, 19TH FLOOR NEW YORK, NY 10017 UNITED STATES sms@msf-law.com,jpw@msf-law.com |
| Submission | Motion to Compel Discovery |
| Filer's Name | Susan M. Schlesinger |
| Filer's e-mail | sms@msf-law.com,jpw@msf-law.com |
| Signature | /Susan M. Schlesinger/ |
| Date | 01/17/2014 |
| Attachments | Opposer's Motion to Compel.pdf(260314 bytes) Declaration of Susan M. Schlesinger and Exhibits.pdf(952415 bytes) |

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/458,112
Published in the *Official Gazette* on June 26, 2012

| | | |
|--|---|--------------------------|
| -----X | : | |
| BHPC Associates LLC | : | |
| Opposer, | : | |
| | : | |
| v. | : | Opposition No.: 91206167 |
| | : | |
| | : | |
| Polo Gear Intellectual Property, Inc., | : | |
| Applicant. | : | |
| -----X | : | |

**OPPOSER’S MOTION TO COMPEL PRODUCTION OF DOCUMENTS AND
ANSWERS TO INTERROGATORIES**

Pursuant to 37 C.F.R. § 2.120(2)(e) and Rule 37 of the Federal Rules of Civil Procedure, Opposer, by and through its attorneys, Meister Seelig & Fein LLP, hereby moves the Trademark Trial and Appeal Board (the “Board”) for an order compelling Applicant to comply with its discovery obligations.

Through this motion to compel (“Motion”), Opposer seeks the following relief from the Board, an order: (i) requiring Applicant to produce documents and provide answers in response to the document requests and interrogatories served on it; and (ii) precluding Applicant from asserting any objections as to the merits of Opposer’s discovery requests, in view of Applicant’s inexcusable failure to comply with its discovery obligations.

STATEMENT OF FACTS

Opposer instituted this opposition proceeding (“Opposition”) by filing and serving a Notice of Opposition objecting to Applicant’s attempt to register the POLOGEAR and Polo

Player Design trademark. (*See* Dkt. No. 1). On November 18, 2013, undersigned counsel was substituted into the Opposition. (*See* Dkt. No. 24). At the time new counsel took over representation of Opposer in this Opposition, counsel became aware that the parties had been in settlement discussions, but that such discussions had not produced a final, enforceable settlement agreement. (*See* Declaration of Susan M. Schlesinger (“Schlesinger Decl.”), ¶ 2). Opposer’s counsel also became aware that discovery was set to close in three days, on November 21, 2013, and that Opposer’s initial disclosures had been previously served on Applicant. (*Id.* at ¶ 2; Dkt. No. 22-23). Opposer’s counsel discussed with Applicant’s counsel its request for an extension of the discovery period, given that settlement was not in place, to which Applicant would not consent. (*Id.* at ¶ 3). Opposer then filed a motion to extend discovery on November 20, 2013, which motion is still pending. (*Id.*; Dkt. No. 25).

Subsequently, on November 21, 2013, while discovery in the Opposition was still open, Opposer served on Applicant, via U.S.P.S. first-class mail, Opposer’s First Set of Interrogatories and Opposer’s First Set of Requests for Production of Documents (collectively, “Opposer’s Requests”). (*See* Schlesinger Decl. ¶ 4, Ex. A). In anticipation that the Board may grant Opposer’s motion to extend discovery, Opposer also served deposition notices on that day. (*Id.* at ¶ 4).¹

Counsel for the parties had a telephone conference on December 30, 2013, to discuss the Opposition and possible settlement, at which time counsel for Opposer raised the issue of not having received documents and interrogatory answers in response to Opposer’s Requests. (*Id.* at ¶ 5). The conference was to resume later in the day. (*Id.*, Ex B). Instead, Counsel for Applicant sent an e-mail to counsel for Opposer that he had unilaterally decided not to continue with

¹ In the interests of preserving its rights, Opposer served deposition notices on Applicant for depositions that would take place only in any extended discovery period set by the Board. Since the Board has not ruled on Opposer’s motion to extend discovery, Opposer’s deposition notices are not at issue in this Motion.

discussions, and further, provided caveats regarding the deposition notices Opposer served -- but said nothing about Opposer's Requests. (*Id.*, Ex. B). Opposer's counsel responded via e-mail putting Applicant's counsel on notice of Applicant's complete failure to comply with or respond at all to Opposer's Requests. (*Id.*, Ex. B). Applicant did not respond to Opposer's counsel's e-mail or provide any documents or any answers responsive to Opposer's Requests. (*Id.* at ¶ 6).

There were further exchanges of e-mails during the first two weeks of January 2014 between counsel for the parties relative to possible settlement of the Opposition. (*Id.* at ¶ 7). On January 16, 2014, counsel for Opposer advised that if there was not a resolution by the end of the day, Opposer would have to proceed with filing a motion to compel Applicant's compliance with Opposer's Requests, given the current Opposition schedule to avoid waiving the right to do so. (*Id.* at ¶ 8). As of the date of this Motion, Applicant has still not provided any answers to Opposer's First Set of Interrogatories or documents in response to Opposer's First Set of Requests for Production of Documents, nor asked for additional time to do so. (*Id.* at ¶ 9). Currently, Opposer's trial period is set to open on January 20, 2014 (*see* Dkt. No. 22-23), and Opposer still has none of the discovery that it timely requested (*See* Schlesinger Decl. at ¶¶ 4, 9).

ARGUMENT

Applicant has failed to comply with its obligations to produce documents in response to Opposer's First Set of Requests for Production of Documents and has failed to answer Opposer's First Set of Interrogatories. Further, Applicant has not provided a reason why it has failed to comply with its discovery obligations. (*Id.* at ¶ 9). There is an urgency here because Opposer's trial period is currently scheduled to start on January 20, 2014. (*See* Dkt. 22-23). Opposer must file this Motion to compel Applicant's compliance with its discovery obligations now or waive its right to do so. *See* 37 C.F.R. 2.120(e)(1); TBMP § 523.01 (explaining that a motion to

compel discovery must be filed before the opening of the first testimony period). Opposer cannot reasonably continue with the Opposition without having responses to Opposer's Requests.

Opposer timely served Opposer's Requests on November 21, 2013 via U.S.P.S. first-class mail. (See Schlesinger Decl. at ¶ 4). Pursuant to 37 C.F.R. §2.120(a)(3), discovery requests can be served "on ... the closing date of the discovery period as originally set or as reset." Responses to interrogatories and requests for production of documents and things must then be served within thirty (30) days from the date of service, except that if service is made by first-class mail an extra five (5) days are allowed. See 37 C.F.R. §2.120(a)(3); TBMP § 403.03; see also *Crane Co. v. Shimano Industrial Co., Ltd.*, 184 U.S.P.Q. 691 (TTAB 1975) (explaining that it was incumbent upon applicant to serve its answers and/or objections to the discovery request within thirty-five days).

Accordingly, if Applicant complied with the rule, Applicant should have served its responses by December 26, 2013. Yet, as of the date of this Motion, Applicant still has not complied with its discovery obligations. (See Schlesinger Dec. at ¶ 9). Opposer, therefore, respectfully requests that the Board order Applicant to provide its answers and documents in response to Opposer's Requests without further delay.

In addition, because Applicant has failed to timely respond to Opposer's Requests, and did not request an extension of time to respond (*see Id.* at ¶¶ 5, 9), Applicant should be precluded from objecting to the merits of Opposer's Requests. See *M.C.I. Foods Inc. v. Bunte*, 86 U.S.P.Q.2d 1044, 1047 (TTAB 2008) (citing *Envirotech Corp. v. Compagnie Des Lampes*, 219 U.S.P.Q. 448, 449 (TTAB 1979) and explaining that because the party "did not timely serve its discovery responses, its objections on the merits of the discovery requests have been waived");

see also Crane Co., 184 U.S.P.Q. at 691 (finding that since applicant did not respond to interrogatories by the due date, “applicant has waived its right to object to the interrogatories on their merits and must reply to them as put”); *No Fear Inc. v. Rule*, 54 U.S.P.Q.2d 1551, 1554 (TTAB 2000) (explaining that the Board “generally will order discovery responses to be provided without objection” when the non-movant has failed to produce responses and has no excusable reason for such failure). Here, Applicant has offered no excuse as to why it has failed to respond to Opposer’s Requests. Accordingly, Applicant should be precluded from raising any objections to the merits of Opposer’s Requests as such right has now been waived.

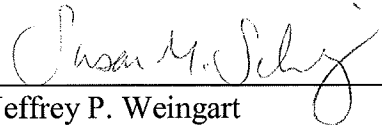
CONCLUSION

Based on the foregoing, Opposer respectfully requests that Applicant be ordered to answer the interrogatories and produce documents in response to Opposer’s Requests without further delay, that Applicant be precluded from raising any objections to the merits of Opposer’s Requests and, further, that the Opposition be suspended pending Opposer’s Motion and dates in the Opposition be reset accordingly.

Dated: January 17, 2014

Respectfully submitted,

MEISTER SEELIG & FEIN LLP



Jeffrey P. Weingart
Susan M. Schlesinger
MEISTER SEELIG & FEIN LLP
140 East 45th Street, 19th Floor
New York, NY 10017
Telephone: 212-655-3500
Fax: 212-655-3535
E-mail: jpw@msf-law.com
sms@msf-law.com
Attorneys for Opposer

CERTIFICATE OF SERVICE AND FILING

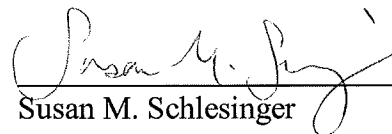
The undersigned hereby certifies that a copy of the foregoing Opposer's Motion to Compel Production of Documents and Answers to Interrogatories was served on the Applicant on the date indicated below by depositing the same with the United States Postal Service, first-class mail, postage pre-paid, to Applicant's correspondent address of record and additional address for Applicant:

Daniel J. Barsky, Esq.
Shutts & Bowen LLP
200 E. Broward Boulevard, Suite 2100
Fort Lauderdale, FL 33301

Daniel J. Barsky, Esq.
Shutts & Bowen LLP
CityPlace Tower
525 Okeechobee Boulevard, Suite 1100
West Palm Beach, FL 33401

and further certifies that the aforementioned Opposer's Motion to Compel Production of Documents and Answers to Interrogatories was filed with the Trademark Trial and Appeal Board on the date indicated below online through the ESTTA system of the United States Patent and Trademark Office.

Dated: January 17, 2014



Susan M. Schlesinger

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/458,112
Published in the *Official Gazette* on June 26, 2012

| | | |
|--|---|--------------------------|
| -----X | : | |
| BHPC Associates, LLC | : | |
| Opposer, | : | |
| | : | |
| v. | : | Opposition No.: 91202167 |
| | : | |
| | : | |
| Polo Gear Intellectual Property, Inc., | : | |
| Applicant. | : | |
| -----X | : | |

DECLARATION OF SUSAN M. SCHLESINGER

I, Susan M. Schlesinger, pursuant to the requirements of 28 U.S.C. §1746, declare that the following is true and correct under the penalties of perjury:

1. I am associated with Meister Seelig & Fein LLP, counsel for Opposer, in this Opposition Proceeding (the "Opposition"). I have been involved with the Opposition since Meister Seelig & Fein LLP was substituted in as counsel on November 18, 2013, and am fully familiar with the facts herein. I submit this declaration in support of Opposer's Motion to Compel.

2. At the time Meister Seelig & Fein LLP was substituted in as counsel, we became aware that the parties had been involved in settlement discussion, but that such discussion had not produced a final, enforceable settlement agreement. We also became aware that discovery was set to close on November 21, 2013, and that Opposer's initial disclosures had previously been served on Applicant.

3. I discussed with Applicant's counsel Opposer's request for an extension of the discovery period in this Opposition and was advised that Applicant would not consent. Accordingly, Opposer filed a motion to extend discovery on November 20, 2013, which motion is still pending.

4. On November 21, 2013, while discovery in the Opposition was still open, Opposer served on Applicant, via U.S.P.S. first-class mail, Opposer's First Set of Interrogatories and Opposer's First Set of Requests for Production of Documents (collectively, "Opposer's Requests"). Attached as Exhibit A are true and correct copies of Opposer's Requests. In anticipation that the Board may grant Opposer's motion to extend discovery, Opposer also served deposition notices on that day.

5. Counsel for the parties had a telephone conference on December 30, 2013, to discuss the Opposition and possible settlement, at which time counsel for Opposer raised the issue of not having received documents and interrogatory answers in response to Opposer's Requests. The conference was to resume later in the day. Instead, Counsel for Applicant sent an e-mail to counsel for Opposer that he had unilaterally decided not to continue with discussions, and further, provided caveats regarding the deposition notices Opposer served -- but said nothing about Opposer's Requests. Opposer's counsel responded via e-mail putting Applicant's counsel on notice of Applicant's complete failure to comply with or respond at all to Opposer's Requests. Attached as Exhibit B is a copy of the e-mail exchange between counsel with portions regarding settlement discussions redacted.

6. Applicant did not respond to Opposer's counsel's e-mail or provide any documents or any answers responsive to Opposer's Requests..

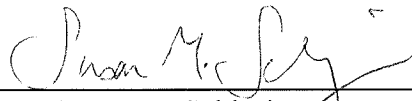
7. There were further exchanges of e-mails during the first two weeks of January 2014 between counsel for the parties relative to possible settlement of the Opposition.

8. On January 16, 2014, counsel for Opposer advised that if there was not a resolution by the end of the day, Opposer would have to proceed with filing a motion to compel Applicant's compliance with Opposer's Requests, given the current Opposition schedule to avoid waiving the right to do so.

9. As of January 17, 2014, Applicant has still not provided any answers to Opposer's First Set of Interrogatories or documents in response to Opposer's First Set of Requests for Production of Documents, nor asked for additional time to do so. Applicant has not provided any reasons why it has not complied with its discovery obligations.

I hereby declare that the foregoing is true and correct under penalty of perjury.

Dated: January 17, 2014



Susan M. Schlesinger

CERTIFICATE OF SERVICE AND FILING

The undersigned hereby certifies that a copy of the foregoing Declaration of Susan M. Schlesinger and Exhibits A-B were served on the Applicant on the date indicated below by depositing the same with the United States Postal Service, first-class mail, postage pre-paid, to Applicant's correspondent address of record and additional address for Applicant:

Daniel J. Barsky, Esq.
Shutts & Bowen LLP
200 E. Broward Boulevard, Suite 2100
Fort Lauderdale, FL 33301

Daniel J. Barsky, Esq.
Shutts & Bowen LLP
CityPlace Tower
525 Okeechobee Boulevard, Suite 1100
West Palm Beach, FL 33401

and further certifies that the aforementioned Declaration of Susan M. Schlesinger and Exhibits A-B were filed with the Trademark Trial and Appeal Board on the date indicated below online through the ESTTA system of the United States Patent and Trademark Office.

Dated: January 17, 2014

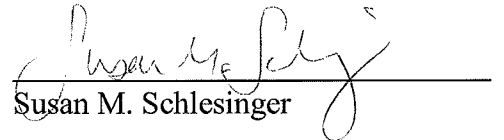

Susan M. Schlesinger

EXHIBIT A

2. As used herein, the term "person(s)" includes not only natural persons, officers, managing agents, supervisory personnel, and employees, but also includes, without limitation, firms, partnerships, associations, corporations and other legal entities, divisions, departments or other units thereof.

3. "Applicant" shall mean Polo Gear Intellectual Properties, Inc.

4. "Opposer" shall mean BHPC Associates LLC.

5. As used herein, the term "Applicant's Mark" shall mean the POLOGEAR and Design trademark as shown in U.S. Application Serial No. 85/458,112.

6. As used herein, the term "Opposer's Marks" shall collectively mean the BEVERLY HILLS POLO CLUB trademark and the BEVERLY HILLS POLO CLUB and Design trademarks as shown in U.S. Registration Nos. 1,429,311; 1,751,058 and 2,214,846.

7. "Notice of Opposition" shall mean the Notice of Opposition filed by Opposer on July 19, 2012 regarding U.S. Application Serial No. 85/458,112.

8. "Answer" shall mean the Answer to Notice of Opposition filed by Applicant on September 27, 2012.

9. The term "concerning," means relating to, referring to, describing, evidencing or constituting, or in any way relevant within the meaning of Rule 26(b)(1) of the Federal Rules of Civil Procedure.

10. The connectives "and" and "or" shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the request all responses that might otherwise be construed as being outside its scope.

11. The term "any" shall mean any and all.

12. The terms "all" and "each" shall be construed as all and each.

13. The use of singular of any word used herein shall also include its plural form and the plural of any word shall also include its singular form.

14. As used herein, the term "document" is used in its broadest sense, to include, without limitation, the following items, whether printed, or recorded, or filmed, or reproduced by any process, or written or produced by hand, and whether or not claimed to be privileged against discovery on any ground, and whether an original, master or copy; including but not limited to, communications, including intra-company communications and correspondence; cablegrams, radio-grams and telegrams; notes and memoranda; summaries, minutes and records of telephone conversations, meetings and conferences, including lists of persons attending meetings .or conferences; summaries and records of personal conversations or interviews; reports; customer lists; books, manuals, publications and diaries; laboratory engineering reports; reports of test results; notebooks; charts; plans; sketches and drawings; photographs; reports and/or summaries of investigations and/or surveys; customer surveys; opinions and reports of consultants; opinions of counsel; reports and summaries of negotiations; brochures; instruction manuals; user manuals; computer software; operation manuals; pamphlets, catalogs and catalog sheets; advertisements, including story board and/or scripts for television commercials; circulars; trade letters; press publicity and trade and product releases; product descriptions; drafts of original or preliminary notes on, and marginal comments appearing on, any document; applications for approval by a governmental agency; other reports and records; and any other information-containing paper, writing or physical thing.

15. As used herein, "communication" means the transmittal of information (in the form of facts, ideas, inquiries or otherwise) and is used in its broadest sense, to include, without limitation, the following:

- (a) any document, as defined in paragraph 14, above; and
- (b) any conversation, discussion, dialogue, conference, report, message,
- (c) account, interview, exchange, and/or consultation, whether oral or written.

16. "Advertising" and/or "promotional materials" shall mean, without limitation, advertisements, including advertising copy, advertising slicks, and line art; product packaging, labels, brochures, photographs, product sheets, point of sale displays, audio or video tapes; catalogues or other product guide books; signage, price lists, warranty information, and/or any other document or material used and/or distributed to promote and/or solicit business, shipments, sales, and/or orders of products or services of Applicant.

17. As used herein, "media" or "medium" shall be construed to comprise newspapers, consumer magazines-trade publications, trade shows, catalogues, and any means of audio or video transmission.

18. "Describe" and/or "state" means to set forth fully and unambiguously every fact relevant to the subject of the Interrogatory, of which Applicant (including its agents and representatives) has knowledge or information.

19. "Identify" (With Respect to Persons). When referring to a person, "to identify" means to give, to the extent known, the person's full name, present or last known address, and phone numbers, and when referring to a natural person, additionally, the present or last known place of employment. Once a person had been identified in accordance with this subparagraph, only the name of that person need be listed in respect to subsequent discovery requesting the identification of that person.

20. "Identify" (With Respect to Documents). When referring to documents, "to identify" means to give, to the extent known, the (i) type of document; (ii) the general subject matter; (iii) the date of the document; and (iv) author(s), addressee(s) and recipient(s).

21. If, in answering these Interrogatories, you claim that any Interrogatory, or a definition or instruction applicable thereto, is ambiguous, do not use such claim as a basis for refusing to respond, but rather set forth as a part of the response the language you claim is ambiguous and the interpretation you have used to respond to the individual Interrogatory.

22. With respect to any interrogatory which is asserted to be over broad, or unduly burdensome, state all information requested which can be provided without undue burden, and/or which is relevant or might lead to the discovery of admissible evidence.

23. Each paragraph herein shall be construed independently and not with reference to any other paragraph for the purpose of limitation.

24. Each of the foregoing definitions and instructions is hereby incorporated by reference into, and shall be deemed a part of, each and every other definition and instruction contained herein as well as each specific Interrogatory set forth below.

INTERROGATORIES

Interrogatory No. 1. Identify the person responding to the Interrogatories.

Interrogatory No. 2. Identify the person(s) with knowledge of the marketing and advertising of each good offered for sale or sold in connection with Applicant's Mark.

Interrogatory No. 3. Identify the person(s) with knowledge as to each and every admission, denial and affirmative defense pled in the Answer.

Interrogatory No. 4. Identify the person(s) with knowledge of use of the Applicant's Mark in commerce from the date of first use through the present.

Interrogatory No. 5. Identify the person(s) with knowledge of total sales (in both units and dollar amounts) of each product offered for sale and/or sold in connection with Applicant's Mark since the date of first use of Applicant's Mark in commerce.

Interrogatory No. 6. Identify all markets, channels of distribution and channels of trade through which Applicant intends to offer or has offered goods for sale and identify all persons knowledgeable thereof and documents related thereto.

Interrogatory No. 7. Set forth in full and specific detail Applicant's advertising, marketing and/or promotional plans for goods which bear Applicant's Mark and identify all persons knowledgeable thereof and all documents related thereto.

Interrogatory No. 8. Identify the person(s) with knowledge of the selection and adoption of Applicant's Mark.

Interrogatory No. 9. State each and every product offered for sale, sold or provided in connection with Applicant's Mark since the date of first use of Applicant's Mark.

Interrogatory No. 10. Identify all person(s) and/or entities that have been licensed to use Applicant's Mark, provide the date(s) of when such license(s) began and terminated, if such license(s) have ended, and provide the terms of such license(s).

Interrogatory No. 11. State the date on which Applicant first become aware of Opposer's Marks.

Interrogatory No. 12. State whether Applicant obtained any trademark search reports or opinions with respect to the Applicant's Mark prior to its adoption and/or use thereof, or at any subsequent time. If so, identify all such documents.

Interrogatory No. 13. Identify all person(s) with knowledge of any trademark search reports or opinions rendered regarding Applicant's Mark.

Interrogatory No. 14. State the total sales per year of each of the products sold in connection with Applicant's Mark for each month from the date of first use of Applicant's Mark to the present.

Interrogatory No. 15. Identify each communication and document in which Applicant, or anyone acting on Applicant's behalf, has enforced any perceived rights with respect to Applicant's Mark and identify all persons knowledgeable thereof and all documents related thereto.

Interrogatory No. 16. Identify all the channels of trade through which goods bearing Applicant's Mark travel.

Interrogatory No. 17. Identify all the retail stores, including but not limited to upper-tier and mass merchandise stores, to whom or through whom Applicant sells goods bearing Applicant's Mark.

Interrogatory No. 18. To the extent not identified in Interrogatory No. 17, identify all discount retail stores to whom or through whom Applicant sells goods bearing Applicant's Mark.

Interrogatory No. 19. Identify the classes of purchasers of Applicant's products bearing Applicant's Mark.

Interrogatory No. 20. State the geographical areas in which Applicant's goods are sold, offered for sale or otherwise used in connection with Applicant's Mark.

Interrogatory No. 21. Describe in detail why Applicant is seeking registration of the POLOGEAR and Design trademark.

Interrogatory No. 22. Describe in detail Applicant's assertion that there is no likelihood of confusion between Opposer's Mark and Applicant's Mark.

Dated: November 21, 2013

MEISTER SEELIG & FEIN LLP

A handwritten signature in cursive script, appearing to read "Susan M. Schlesinger", is written over a horizontal line.

Jeffrey P. Weingart

Susan M. Schlesinger

MEISTER SEELIG & FEIN LLP

140 East 45th Street, 19th Floor

New York, NY 10017

Telephone: 212-655-3500

Fax: 212-655-3535

E-mail: jpw@msf-law.com

sms@msf-law.com

Attorneys for Opposer

BHPC Associates LLC

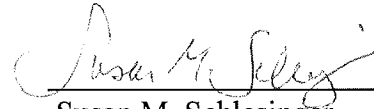
CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Opposer's First Set of Interrogatories was served on the Applicant on the date indicated below by depositing the same with the United States Postal Service, first class mail, postage pre-paid, to Applicant's correspondent address of record and additional address for Applicant:

Daniel J. Barsky, Esq.
Shutts & Bowen LLP
200 E. Broward Boulevard, Suite 2100
Fort Lauderdale, FL 33301

Daniel J. Barsky, Esq.
Shutts & Bowen LLP
1100 CityPlace Tower
525 Okeechobee Boulevard
West Palm Beach, FL 33401

Dated: November 21, 2013



Susan M. Schlesinger

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 85/458,112
Mark: POLOGEAR and Design
Published in the *Official Gazette* on June 26, 2012

| | | |
|------------------------|---|--------------------------|
| -----X | : | |
| BHCP ASSOCIATES LLC, | : | |
| Opposer, | : | |
| | : | |
| v. | : | Opposition No.: 91206167 |
| | : | |
| | : | |
| POLO GEAR INTELLECTUAL | : | |
| PROPERTIES, INC., | : | |
| Applicant. | : | |
| -----X | : | |

OPPOSER'S FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS

Pursuant to 34 of the Federal Rules of Civil Procedure, and 37 C.F.R. § 2.120, Opposer by its attorneys Meister Seelig & Fein LLP, hereby requests that Applicant produce the documents and things described below (the "Requests") to the offices of Meister Seelig & Fein LLP, 140 East 45th Street, 19th Floor, New York, NY 10017, Attn: Jeffrey P. Weingart, Esq. within thirty (30) after service of these Requests, in accordance with the Federal Rules of Civil Procedure and the Trademark Rules of Practice.

INTRODUCTION AND DEFINITIONS

1. In accordance with Rule 26 of the Federal Rules of Civil Procedure, these Requests are continuing and any document obtained subsequent to production that would have been produced had it been available or its existence been known is to be produced forthwith.
2. As used herein, the term "person(s)" includes not only natural persons, officers, managing agents, supervisory personnel, and employees, but also includes, without limitation,

firms, partnerships, associations, corporations and other legal entities, divisions, departments or other units thereof.

3. "Applicant" shall mean Polo Gear Intellectual Properties, Inc.

4. "Opposer" shall mean BHPC Associates LLC.

5. As used herein, the term "Applicant's Mark" shall mean the POLOGEAR and Design trademark as shown in U.S. Application Serial No. 85/458,112.

6. As used herein, the term "Opposer's Marks" shall collectively mean the BEVERLY HILLS POLO CLUB trademark and the BEVERLY HILLS POLO CLUB and Design trademark as shown in U.S. Registration Nos. 1,429,311; 1,751,058 and 2,214,846.

7. "Notice of Opposition" shall mean the Notice of Opposition filed by Opposer on July 19, 2012 regarding U.S. Application Serial No. 85/458,112.

8. "Answer" shall mean the Answer to Notice of Opposition filed by Applicant on September 27, 2012.

9. The term "concerning," means relating to, referring to, describing, evidencing or constituting, or in any way relevant within the meaning of Rule 26(b)(1) of the Federal Rules of Civil Procedure.

10. The connectives "and" and "or" shall be construed either disjunctively or conjunctively as necessary to bring within the scope of the request all responses that might otherwise be construed as being outside its scope.

11. The term "any" shall mean any and all.

12. The terms "all" and "each" shall be construed as all and each.

13. The use of singular of any word used herein shall also include its plural form and the plural of any word shall also include its singular form.

14. As used herein, the term "document" is used in its broadest sense, to include, without limitation, the following items, whether printed, or recorded, or filmed, or reproduced by any process, or written or produced by hand, and whether or not claimed to be privileged against discovery on any ground, and whether an original, master or copy; including but not limited to, communications, including intra-company communications and correspondence; cablegrams, radio-grams and telegrams; notes and memoranda; summaries, minutes and records of telephone conversations, meetings and conferences, including lists of persons attending meetings .or conferences; summaries and records of personal conversations or interviews; reports; customer lists; books, manuals, publications and diaries; laboratory engineering reports; reports of test results; notebooks; charts; plans; sketches and drawings; photographs; reports and/or summaries of investigations and/or surveys; customer surveys; opinions and reports of consultants; opinions of counsel; reports and summaries of negotiations; brochures; instruction manuals; user manuals; computer software; operation manuals; pamphlets, catalogs and catalog sheets; advertisements, including story board and/or scripts for television commercials; circulars; trade letters; press publicity and trade and product releases; product descriptions; drafts of original or preliminary notes on, and marginal comments appearing on, any document; applications for approval by a governmental agency; other reports and records; and any other information-containing paper, writing or physical thing.

15. As used herein, "communication" means the transmittal of information (in the form of facts, ideas, inquiries or otherwise) and is used in its broadest sense, to include, without limitation, the following:

- (a) any document, as defined in paragraph 14, above; and
- (b) any conversation, discussion, dialogue, conference, report, message,
- (c) account, interview, exchange, and/or consultation, whether oral or written.

16. "Advertising" and/or "promotional materials" shall mean, without limitation, advertisements, including advertising copy, advertising slicks, and line art; product packaging, labels, brochures, photographs, product sheets, point of sale displays, audio or video tapes; catalogues or other product guide books; signage, price lists, warranty information, and/or any other document or material used and/or distributed to promote and/or solicit business, shipments, sales, and/or orders of products or services of Applicant.

17. As used herein, "media" or "medium" shall be construed to comprise newspapers, consumer magazines-trade publications, trade shows, catalogues, and any means of audio or video transmission.

18. In responding to the Requests, Applicant is required to furnish all documents that are available to the Applicant, including documents in the possession, custody or control of Applicant's attorneys, agents, employees, representatives, or any other persons or entities directly or indirectly employed by or connected with Applicant or his attorneys, or subject to Applicant's control.

19. If Applicant objects to the production of any document based on a claim of any privilege or a claim that such documents constitute attorney work product, Applicant is hereby requested to provide the information required by Rule 26(b)(5) of the Federal Rules of Civil Procedure, including the following information: (i) the date of the document; (ii) the name of the document's originator, the name of the person(s) to whom it is addressed, and the names of all person(s) who were shown copies or to whom copies were distributed; (iii) a general physical description of the type of document, and the subject matter to which it pertains; (iv) the

document's current custodian; and (v) the precise grounds on which the claim of privilege or other objection to production is based.

20. Each Request seeks the production of the document in its entirety, without abbreviation or redaction. If any information is redacted from a document, clearly mark the redacted document with the words "REDACTED," and state the basis for the redaction of the information.

21. If for any Request there are no documents that are responsive, so state.

22. If any responsive document has been, but no longer is, in Applicant's possession, custody or control, provide a list of such documents containing the following information: (i) the date of the document; (ii) its title, if any; (iii) a description of the subject matter of the document; and (iv) the names and addresses of each person who prepared, received, reviewed and has or has had possession, custody or control of the document.

23. If, in answering these Requests, you claim that any Request, or a definition or instruction applicable thereto, is ambiguous, do not use such claim as a basis for refusing to respond, but rather set forth as a part of the response the language you claim is ambiguous and the interpretation you have used to respond to the individual Request.

24. Each paragraph herein shall be construed independently and not with reference to any other paragraph for the purpose of limitation.

25. Each of the foregoing definitions and instructions is hereby incorporated by reference into, and shall be deemed a part of, each and every other definition and instruction contained herein as well as each specific Request set forth below.

REQUESTS

Request No. 1. All documents described in Polo Gear Intellectual Properties, Inc.'s Initial Disclosures.

Request No. 2. All documents and communications concerning the date of first use claimed by Applicant for Applicant's Mark.

Request No. 3. All documents and communications concerning the date of first use in commerce claimed by Applicant for Applicant's Mark.

Request No. 4. All documents and communications concerning continuous use in commerce by Applicant of Applicant's Mark for each good identified in U.S. Application Serial No. 85/458,112.

Request No. 5. All documents and communications concerning the selection and adoption of Applicant's Mark.

Request No. 6. All documents and communications concerning any trademark searches, trademark search reports or trademark opinions regarding Applicant's Mark.

Request No. 7. All documents and communications concerning any license to use Applicant's Mark to any person or entity other than Applicant.

Request No. 8. All documents and communications concerning use of Applicant's Mark by any person or entity other than Applicant.

Request No. 9. All documents and communications concerning the conditions under which products bearing Applicant's Mark are sold, including but not limited to, documents evidencing any point of sale advertising that the consumer would encounter when purchasing products offered for sale or sold in connection with Applicant's Mark.

Request No. 10. All documents and communications concerning the classes of purchasers to whom sales of products bearing Applicant's Mark are targeted.

Request No. 11. All documents and communications concerning the classes of purchasers who purchase products bearing Applicant's Mark.

Request No. 12. All documents and communications concerning the total sales per month for each month from the date of first use of Applicant's Mark to the present for each product sold in connection with Applicant's Mark.

Request No. 13. All documents and communications concerning the total revenue per year received by Applicant regarding products sold in connection with Applicant's Mark from the date of first use of Applicant's Mark to the present.

Request No. 14. All documents and communications concerning Applicant's awareness or knowledge of any other person or entity using a service mark, trademark or trade name that contains the image of a polo player on horseback swinging a mallet.

Request No. 15. All documents and communications concerning Applicant's efforts to prevent other persons or entities from using a service mark, trademark or trade name that contains the image of a polo player on horseback swinging a mallet.

Request No. 16. All documents and communications concerning Applicant's efforts to prevent other persons or entities from using a service mark, trademark or trade name that contain the word "polo."

Request No. 17. All documents and communications concerning Applicant's contention in paragraph 2(c) of the Answer that: "the Applicant's Mark creates a distinct commercial impression from Opposer's Marks."

Request No. 18. All documents and communications concerning Applicant's contention in paragraph 2(d) of the Answer that: "Applicant's products and the products offered by the Opposer move in different channels of trade to different classes of consumers."

Request No. 19. All documents and communications concerning Applicant's contention in paragraph 2(d) of the Answer that: "Applicant has had a long-standing reputation and involvement in the actual sport of polo and amongst polo players and within the polo community. Applicant is well-recognized in the sport."

Request No. 20. All documents and communications concerning Applicant's contention in the Third Affirmative Defense of the Answer that: "the parties have thus far coexisted in their use of their respective Marks, on the respective goods, as outlined in their trademark applications and/or registrations, since at least as early as December 31, 1995, without a single instance of consumer or other confusion."

Request No. 21. All documents and communications concerning Applicant's contention in the Fourth Affirmative Defense of the Answer that: "Applicant's mark and Opposer's marks have and create distinct commercial impressions."

Request No. 22. All documents and communications concerning Applicant's contention in the Fifth Affirmative Defense of the Answer that: "Opposer has failed to adequately maintain, police, or enforce any trademark or property rights it may have in its alleged marks."

Request No. 23. All documents and communications concerning Applicant's contention in the Sixth Affirmative Defense of the Answer that: "Opposer's alleged marks are not famous."

Request No. 24. All documents and communications concerning advertising and/or promotional expenditures for all goods offered for sale by Applicant under Applicant's Mark.

Request No. 25. All documents and communications, if any, concerning any press regarding goods sold under Applicant's Mark.

Request No. 26. All documents and communications concerning any co-existence and/or settlement agreements with third parties regarding Applicant's use and/or registration of Applicant's Mark.

Request No. 27. Representative specimens of all goods, packaging, advertising and promotional materials bearing Applicant's Mark.

Request No. 28. All documents and communications evidencing the geographic scope of advertising, distribution and sale of goods or services bearing Applicant's Mark.

Request No. 29. All documents and communications concerning the markets and channels of trade in the United States through which Applicant markets and/or sells goods bearing Applicant's Mark.

Request No. 30. All documents and communications concerning any consumer or market survey, test or study conducted by or on behalf of Applicant regarding the public's recognition of Applicant's Mark.

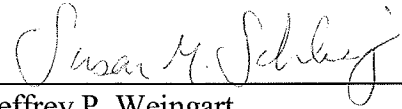
Request No. 31. All documents and communications concerning any plan Applicant has to expand the use of Applicant's Mark to other goods and/or services other than the goods listed in U.S. Application No. Serial No. 85/458,112.

Request No. 32. All documents and communications, other than those already requested, upon which Applicant intends to rely in connection with Opposition No. 91206167.

Request No. 33. All documents and communications not otherwise produced in response to another request herein regarding Applicant's Mark.

Dated: November 21, 2013

MEISTER SEELIG & FEIN LLP



Jeffrey P. Weingart
Susan M. Schlesinger
MEISTER SEELIG & FEIN LLP
140 East 45th Street, 19th Floor
New York, NY 10017
Telephone: 212-655-3500
Fax: 212-655-3535
E-mail: jpw@msf-law.com
sms@msf-law.com
Attorneys for Opposer

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing Opposer's First Set Requests for Production of Documents was served on the Applicant on the date indicated below by depositing the same with the United States Postal Service, First Class Mail, postage pre-paid, to Applicant's correspondent address of record and additional address for Applicant:

Daniel J. Barsky, Esq.
Shutts & Bowen LLP
200 E. Broward Boulevard, Suite 2100
Fort Lauderdale, FL 33301

Daniel J. Barsky, Esq.
Shutts & Bowen LLP
1100 CityPlace Tower
525 Okeechobee Boulevard
West Palm Beach, FL 33401

Dated: November 21, 2013

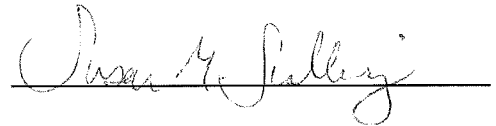


EXHIBIT B


Susan M. Schlesinger

From: Jeffrey P. Weingart
Sent: Monday, December 30, 2013 3:33 PM
To: John F. Mariani
Cc: Daniel Barsky; Susan M. Schlesinger
Subject: RE: BHPC


John:

I presume you mean "not necessary" in your email below.

I had just called Dan's office at 2 p.m. and left him a message to please call as discussed when I received your email. By the way, Dan was aware that I had a call at 11:30 this morning when you guys finally called me at 11:17. I was prepared to resume our discussion this afternoon as planned before you pulled the plug.



We reserve the right to object to your failure to timely and properly respond to our discovery requests, and note that you have already waived your client's right to object to them or to respond to our enlargement motion.



Regards.

Jeff

Jeff Weingart
Meister Seelig & Fein LLP
(212) 655-3516

From: John F. Mariani [mailto:JMariani@shutts.com]
Sent: Monday, December 30, 2013 2:01 PM
To: Jeffrey P. Weingart
Cc: Daniel Barsky
Subject: BHPC

Jeff-

Upon further thought, it seems a telephone call at 2:00pm today is necessary.

Concerning your efforts to conduct discovery, it is our position the discovery period is closed, and your motion to enlarge the discovery period has not been granted. If your motion for enlargement is granted and you are entitled to take depositions, we will produce the deponents in West Palm Beach, Florida. Because we are under no duty to produce them in New York, we will not do so.



Founded 1910

John F. Mariani

Partner

Shutts & Bowen LLP

1100 CityPlace Tower, 525 Okeechobee Boulevard | West Palm Beach, FL 33401

1500 Miami Center, 201 South Biscayne Boulevard | Miami, FL 33131

Direct: (561) 650-8528 | Fax: (561) 671-5902 | Cell: (561) 310-5166

[E-Mail](#) | [Biography](#) | [V-Card](#) | [Website](#)

Please consider the environment before printing this email

IRS CIRCULAR 230 NOTICE: Pursuant to recently enacted U.S. Treasury Department Regulations, we are now required to advise you that, unless otherwise expressly indicated, any federal tax advice expressed above was neither written nor intended by the sender or this firm to be used and cannot be used by any taxpayer for the purpose of avoiding penalties that may be imposed under U.S. tax law. If any person uses or refers to any such tax advice in promoting, marketing or recommending a partnership or other entity, investment plan or arrangement to any taxpayer, then the advice should be considered to have been written to support the promotion or marketing by a person other than the sender or this firm of that transaction or matter, and such taxpayer should seek advice based on the taxpayer's particular circumstances from an independent tax advisor.

The information in this email transmission is privileged and confidential. If you are not the intended recipient, nor the employee or agent responsible for delivering it to the intended recipient, you are hereby notified that any dissemination or copying of this transmission (including any attachments) is strictly prohibited. If you have received this email in error, please notify the sender by email reply.
Thank you.